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10/725,991	12/02/2003	Michael M. Evans	2553.2.3	5217

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EXAMINER

DANIELS, MATTHEW J

ART UNIT	PAPER NUMBER
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1732

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/725,991

Applicant(s)

EVANS ET AL.

Examiner

Matthew J. Daniels

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Objections set forth previously are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim rejections set forth previously under this section are withdrawn in view of the amended claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim rejections set forth previously under this section are withdrawn in view of the amended claims.

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4. **Claims 1, 2, 5-29, 31-52, and 54-60** are rejected under 35 U.S.C. 103(a) as obvious over Johnson (USPN 2629135) in view of De Paoli (USPN 2835996). **As to Claim 1**, Johnson teaches a method for decorating a cementitious substrate, the method comprising:

Selecting a base color scheme for a substrate formed of cementitious material (4:1-28);

Selecting an accent color scheme (3:1-50);

Providing the substrate having the base color scheme and a top surface (Fig. 2, item 5);

Applying before curing, onto a portion of the top surface of the substrate, a distribution of medallions of a cementitious material as accents, colored in the accent color scheme (Item B in Fig. 2);

Curing together the substrate and the medallions (5:19-26), leaving the medallions bonded onto the top surface and extending above the top surface (Fig. 3).

Johnson does not appear to teach (a) that the substrate is provided prior to the application of the medallions or (b) that the distribution of medallions is “substantially random”.

However, these aspects of the invention would have been prima facie obvious for the following reasons:

(a,b) De Paoli teaches a method for decorating a cementitious substrate (1:61), the method comprising:

selecting a base color scheme for a substrate formed of a cementitious material (1:59-65);

selecting an accent color scheme (2:1-15);

providing the substrate having the base color scheme and a top surface (1:59-65) *prior to the application of the medallions* (1:62-72);

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applying before curing, to the exposed portion of the surface of the substrate, a *substantially random distribution* of medallions of a cementitious material as accents (see “distributed irregularly” at 2:32), colored in the accent color scheme (2:1-15);

curing together the substrate of the accent medallions to form a durable, bonded, color-accented substrate (2:13-19).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of DePaoli into that of Johnson in order to provide unusually beautiful and novel artistic effects (1:20-22), ornamental designs (1:40-41), and because DePaoli teaches that a substrate may be used interchangeably with semi-plastic cement, as taught by Johnson (3:10-20, 2:39-44).

As to Claim 2, De Paoli clearly teaches a process of using a strike off board or straight edge in a sawing motion (2:60-61), which would obviously texture the top surface and would obviously provide a substantially random pattern. **As to Claims 5-21, and 54-60**, De Paoli clearly provides teaching and suggestion that “The colors of the base terrazzo and the colors of the terrazzo spatter inserts can be varied to produce unusual artistic effects.” (2:28-30) Additionally, De Paoli teaches “cement...which is of uniform or complementary color with the terrazzo colors.” (3:15-18). Clearly De Paoli suggests a wide range of colors and effects, which would obviously be of different colors, inherently corresponding to or matching natural tones, hues, minerals, ages, biota, metal oxides, deposits, and plants, and reads on the claimed invention.

As to Claim 22, Johnson teaches medallions formed of cement, water, and aggregate (3:15-40). De Paoli also teaches that the medallions are formulated of a cementitious material

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which contains cement, water, and aggregate (2:1-15). De Paoli teaches cement and aggregate (2:4-5), but does not explicitly teach the water, however, it would have been inherent or obvious that it also contains water in that the spatters are “semi-plastic” (2:8), which would not occur without water addition.

As to Claims 23-29, 31-33, De Paoli teaches a proportion of about 20% Portland cement to aggregate (2:48-58), that the particular consistency should be changed by adjusting the proportions of aggregate and cement (2:59-63), sand that could be used as masonry sand (2:51), and varying degrees of pigment (3:11-20 and 2:26-35) and water (2:48-59). De Paoli therefore teaches that color, cement/aggregate ratio, and water represent result effective variables which should be optimized in order to produce unusual artistic effects and provide the most optimum and driest possibly consistency.

As to Claims 34-40, De Paoli clearly suggests that the medallions should be “inserted in selected areas of the semi-plastic slab to form a suitable design.” (2:1-2). Also see De Paoli’s teaching of “semi-plastic or partially cured state” (2:68-69). De Paoli clearly teaches that the ordinary artisan should choose or select a time at which the mixture is still plastic, which would have suggested to the ordinary artisan (a) any time over 1 second; and (b) that time at placement also represents a result effective variable that should be optimized to maintain the semi-plastic layer. Doing so would obviously provide integrated cohesion, as claimed.

As to Claims 41-43, the medallions of De Paoli are formed of a cement material which would have a liquid content and depth which would obviously or inherently simulate the appearance of biota.

As to Claims 44-47 and 52, De Paoli clearly suggests texturing the material by working with a sawing motion and a strike-off board or straight-edge (2:60-61), which would inherently or obviously produce random linear patterns, longitudinal patterns, and obtuse angles. The teachings of De Paoli are interpreted to be a manual brushing step, and moreover, the Examiner takes official notice that the texturing steps of Claims 44-47 and 52 are conventional in the art.

As to Claims 48-51, the claimed subject matter appears to be a limitation drawn to requirement of the occupation of the individual choosing the color scheme. The Examiner asserts that De Paoli performing his disclosed process is both a producer, designer, architect, and user.

5. **Claims 3, 4, and 30** are rejected under 35 U.S.C. 103(a) as obvious over Johnson (USPN 2629135) in view of De Paoli (USPN 2835996), and further in view of Arpin (USPN 2918385). Johnson and De Paoli teach the subject matter of Claims 1 and 22 above under 35 USC 103(a). **As to Claims 3, 4, and 30**, De Paoli clearly teaches that the “driest consistency possible” (2:59-60) should be used, but is silent to low or zero slump concrete. However, Arpin teaches low to zero slump concrete (2:15-20), which would be the driest consistency possible as it would not provide excess water to cause slumping. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Arpin into that of Johnson and De Paoli in order to provide the driest consistency possible, as suggested by De Paoli, and to provide a quick setting material.

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6. **Claim 53** is rejected under 35 U.S.C. 103(a) as obvious over Johnson (USPN 2629135) in view of De Paoli (USPN 2835996), and further in view of Maletic (USPN 4940358). Johnson and De Paoli teach the subject matter of Claim 44 above under 35 USC 103(a). **As to Claim 53**, Johnson and De Paoli appears to be silent to a texturing process which comprises automatically and mechanically brushing the substrate by a mechanical device. However, Maletic teaches a texturing process which comprises automatically and mechanically brushing the substrate by a mechanical device (Figs. 1-8). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Maletic into that of Johnson and De Paoli in order to provide a textured surface which would avoid slipping and which efficiently performs the texturing task.

7. **Claims 12, 15-20 and 54-60** are rejected under 35 U.S.C. 103(a) as obvious over Johnson (USPN 2629135) in view of De Paoli (USPN 2835996), and further in view of Gundlach (USPN 2057679) and Chaffee (USPN 1993086). Johnson and De Paoli teach the subject matter of Claim 1 above under 35 USC 102(b), or alternatively, under 35 USC 103(a). **As to Claims 12, 15-20 and 54-60**, Johnson suggests that colors should be used for the “medallions” (column 3) and De Paoli clearly provides teaching and suggestion that “The colors of the base terrazzo and the colors of the terrazzo spatter inserts can be varied to produce unusual artistic effects.” (2:28-30). Additionally, De Paoli teaches “cement...which is of uniform or complementary color with the terrazzo colors.” (3:15-18). De Paoli suggests a wide range of colors and effects, which would obviously be of different colors, inherently corresponding to or

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matching natural tones, hues, minerals, ages, biota, metal oxides, deposits, and plants, and reads on the claimed invention.

Although De Paoli is believed to suggest all color variations, De Paoli does not explicitly teach that the colors simulate biota. "Biota" may be interpreted to be any of the colors that simulate those of biota found in nature (the interpretation set forth in the rejection of Claims 12, 15-20 and 54-60 under 35 USC 103(a) over De Paoli). Alternatively, "biota" may be interpreted to be a green color. In this alternative interpretation, De Paoli is silent to the biota colors. However, Gundlach teaches that green pigment may be mixed with aggregates and cement to form objects that are suitable as medallions (page 1, left column, line 54 - page 1, right column, line 39) and Chaffee teaches that it is conventional to provide cementitious roofing tiles with a green coloring (page 2, left column, line 25 – page 2, right column, line 51). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the methods of Gundlach and Chaffee into that of Johnson and De Paoli in order to provide cement having a highly weather resistant, aesthetically pleasing, and natural looking coloring to the articles of Johnson and De Paoli. Also note that Chaffee additionally suggests at least one texture (page 2, left column, lines 56-68).

Response to Arguments

8. Applicant's arguments filed 1 February 2007 have been fully considered but they are not persuasive. The arguments appear to be on the grounds that amended claim 1 requires that the medallions be applied onto the top surface of a substrate such that they extend above the top surface.

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9. These arguments are not persuasive because firstly they are drawn only to the shape of the resulting composite, which has been generally held to be insufficient to distinguish an invention from the prior art. See MPEP 2144.04 and *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.). Here Applicant's remarks are directed solely at the alleged failure to teach a particular configuration (medallions which extend above the top surface), but do not establish that there is any criticality or difference in the claimed process from the process of the prior art. Additionally, Johnson teaches that which is alleged to be lacking in a new rejection above under 35 USC 103(a).

Limitations recited by dependent claims are not particularly argued.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJD 4/9/07



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4/12/07